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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,069	04/10/2001	Marshall S. Runge	D6179C1P	8710

7590

05/15/2003

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EXAMINER

GOLDBERG, JEANINE ANNE

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/832,069

Applicant(s)

RUNGE ET AL.

Examiner

Jeanine A Goldberg

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 6-10.

Claim(s) objected to: 3 and 4.

Claim(s) rejected: 1, 2 and 11-13.

Claim(s) withdrawn from consideration: NONE.

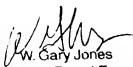
8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: The instant amendments raise new issues. Claim 3 is proposed to be cancelled. Claim 4 depends upon Claim 3, however, 3 was proposed to be cancelled. Therefore, Claim 4 would have depended upon a cancelled claim. .

Continuation of 5. does NOT place the application in condition for allowance because: The response argues the amendment overcomes the rejections under 102 for claims 1-2. This argument is directed solely to the unentered amendment.

With respect to the 103 rejection over Claims 11-13, the response traverses the rejection. The response argues each of the references individually. The response argues specifically that Herrnstadt does not teach the quantification of mtDNA damage nor atherosclerosis a disease associated with altered mitochondrial function. The Herrnstadt reference does teach the criteria of alterations in mitochondria function as measured by the amounts of DNA present in the sample as a way to evaluate efficacy of a drug, as asserted by the response. Therefore, given the teachings in the art that mtDNA damage is associated with atherosclerosis and the teachings of Herrnstadt that alterations/damage that affected mitochondrial function may be evaluated for efficacy of a drug, the ordinary artisan would have been motivated to screen for drug efficacy. As previously provided in the rejection, once mtDNA damage is associated with atherosclerosis, methods of determining drug efficacy is obvious. There is a reasonable expectation of success for the screening assay of Claims 11-13. The claims do not require any specific result. Therefore a mere screening of agents would have a reasonable expectation of success.

Therefore, the after final response fails to place the case in condition for allowance.


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